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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,549	10/23/2003	Johann Holzleitner	1086849	6446

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EXAMINER

KRAUSE, JUSTIN MITCHELL

ART UNIT	PAPER NUMBER
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3682

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07/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/690,549	Applicant(s) HOLZLEITNER, JOHANN	
	Examiner Justin Krause	Art Unit 3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 15-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 19-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 May 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14, and 19-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant's definition supplied in the Remarks filed on May 7, 2007 contradicts the definition supplied in the specification as filed on page 10, and makes no distinction between positive and non-positive connection. It is unclear which definition applicant wishes to apply to the claims. From the definition in the remarks, it appears as if a positive connection can be an operable connection, which is not permitted by the definitions provided in the specification.

It is unclear how applicant regards claim 5 as readable on the elected embodiment. Claim 5 recites, "[A]t least one driving disk connected positively to the intermediate shaft," which is recited explicitly in the non-elected embodiment of specification paragraph 0043. Under applicant's definition of a "positive connection" on page 10 as a rigid connection made by fastening two elements together, it is not clear how applicant regards claim 5 as readable on the elected embodiment which requires the driving disk to be positively connected to the hub. While the hub is disposed on the intermediate shaft, applicants definition of "positive connection" does not permit

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another element to be disposed between the two elements that are positively connected.

Regarding claim 6, it is unclear how the hub can be disposed between the driving disk and the intermediate shaft, if the driving disk is "positively connected" to the intermediate shaft.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-14, and 19-20, as best understood applying the definition supplied in the remarks dated May 7, 2007, are rejected under 35 U.S.C. 102(b) as being anticipated by Whitney (US Patent 1,883,432).

Whitney discloses a starter assembly comprising:

- A starter motor (8)
- An intermediate shaft (37)
- A first gear (29) to transmit rotational motion between the motor output shaft (9) and the intermediate shaft
- A friction plate clutch (39) associated with the first gear which operatively decouples the first gear from the intermediate shaft

-A second gear (28) operatively connected to the intermediate shaft and a third gear (4) operatively connected to the crank shaft.

-A clutch (48,51) associated with the second gear.

Regarding claim 2, the second gear moves axially to couple and decouple with the third gear.

Regarding claim 4, the first and second gears are both disposed on the intermediate shaft at positions axially offset from each other.

Regarding claim 5, the friction plate clutch comprises at least one driving disk positively connected to the intermediate shaft and non-positively connected to the first gear.

Regarding claim 6, a hub is disposed between the driving disk and the intermediate shaft, positively connecting the driving disk to the intermediate shaft.

Regarding claim 11, the first gear is a ring gear mounted rotatably on the intermediate shaft.

Regarding claim 12, a bearing (13) is disposed between the first gear and the intermediate shaft to facilitate rotation.

Regarding claim 19, a hub (26) is provided on the intermediate shaft and connects the friction plate clutch to the intermediate shaft.

Regarding claim 20, the hub is rigidly connected to the intermediate shaft.

Claims 1-3, 5-10, 11-14, as best understood applying the definition supplied in the remarks dated May 7, 2007, are rejected under 35 U.S.C. 102(b) as being anticipated by Froment (US Patent 4,883,185).

Froment discloses a starter assembly, disclosed as an electric starter (the specification references a drive motor in col 2, line 57) and a motor must inherently be present, an intermediate shaft (21), a first gear (32) operatively connected to the motor output shaft and the intermediate shaft, a friction plate clutch (6) associated with the first gear, a second gear (1) operatively connected between the intermediate shaft and a third gear associated with the crank shaft, and a clutch associated with the second gear (2). A third gear is inherently present and operatively connected to the crankshaft to transmit power from the second gear to the crankshaft to start the engine.

Regarding claim 2, the limitations of claim 2 describe how the device operates and does not introduce additional structure to further limit the claimed invention. The device of Froment is capable of performing the claimed function.

Regarding claim 3, the friction plate clutch forms a non-positive connection between the first gear and the intermediate shaft.

Regarding claim 5, the friction plate clutch comprises at least one driving disk positively connected to the intermediate shaft and non-positively connected to the first gear.

Regarding claim 6, a hub is disposed between the driving disk and the intermediate shaft, positively connecting the driving disk to the intermediate shaft.

Regarding claim 11, the first gear is a ring gear mounted rotatably on the intermediate shaft.

Regarding claim 12, a bearing (the sliding surface between 34 and the end of the shaft), is disposed between the first gear and the intermediate shaft.

Allowable Subject Matter

Claims 21-23 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The examiner also notes that if claim 6 were dependent from claim 1, claim 6 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph.

Response to Arguments

Applicant's arguments filed May 7, 2007 have been fully considered but they are not persuasive.

Applicant's arguments provide a contradictory and broader definition of "positively connected" than the definition provided within the specification. It cannot be determined what the metes and bounds of the term are, and in light of the remarks, it is unclear how positively connected, which is defined in the specification as rigid, is

differentiated from an operative connection, as well as how applicant considered it possible to interpose a third element between a positive connection, when the specification expressly defines the rigid connection to be between two members.

Regarding the rejections under 35 U.S.C. 102(b) with the Whitney and Froment references, to the extent understood applying the definition applicant has supplied in the remarks dated, May 7, 2007, the prior art of record is deemed to anticipate all of the positively recited structure in the claims under a broad and reasonable interpretation of the claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin Krause whose telephone number is 571-272-3012. The examiner can normally be reached on Monday - Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMK
7/11/07
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Thomas R. Hannon
Primary Examiner